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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,874	11/17/2000	Carl M. Sullivan	30222/20:100	7638
23446	7590	06/14/2006	EXAMINER	
MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661			FERGUSON, LAWRENCE D	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/715,874

Applicant(s)

SULLIVAN ET AL.

Examiner

Lawrence D. Ferguson

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4,5,8-11,18,19,21-23 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22,23,25,26 and 29 is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,8-11,18,19,21 and 27-28 is/are rejected.
- 7) ☒ Claim(s) 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

1. This action is in response to the amendment mailed April 4, 2006.  
Claims 18 and 22 were amended and claim 30 was added rendering claims 1-2, 4-5, 8-11, 18-19, 21-23 and 25-30 pending.

***Claim Rejections – 35 USC § 102(b)***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 4-5, 8-11, 18-19, 21, 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Greenlee (U.S. 5,248,546).

Greenlee discloses a multilayered article comprising a first layer of polyvinyl chloride and a second layer of polyvinyl chloride, which are adjacent to each other (column 2, lines 17-45) where the PVC compounds contain plasticizers (column 5, lines 8-14). Greenlee discloses the PVC containing layers comprise antistatic agents having levels less than 20phr(column 6, lines 44-55) which is a surface reactive agent. The reference discloses the epoxized soybean oil plasticizer (second plasticizer) ranges from 0.5 to 10 phr (column 5, lines 56-65) and a polyester plasticizer such as adipates,

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where at least one optical plasticizer may be included in any layer (column 5, lines 66-67, column 6, lines 27-28 and column 15, lines 1-5). Greenlee discloses along with the addition of plasticizers, copolymers can be incorporated in the layers as well (column 6, lines 20-26) such as polyester adipates (column 14, line 56 through column 15, line 5). In instant claim 18, the phrase, 'a total thickness of up to 2 mil' equates to 0 mil, which is met by the prior art reference. The reference discloses the second layer is at least three degrees Celsius higher than the heat distortion temperature (melting point) of the first layer (column 2, lines 36-40). In claim 18, the phrase, "degree of stiffness suitable for wrapping foods and an oxygen transmission rate suitable for wrapping foods" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform.

4. Claims 22-23, 25-26 and 29 are allowable. The closest prior art does not teach or suggest the recited packaging film further including the limitation of independent claim 22, which states, wherein "one of said at least two layers melts and seals to itself when heat is transferred through the other layer." The prior art does not teach motivation or suggestion for modification to make the invention as instantly claimed.

5. Claim 30 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The closest prior art does not teach or suggest

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the recited packaging film further including "wherein the primary plasticizer is di(2-ethyl-hexyl) adipate." The prior art does not teach motivation or suggestion for modification to make the invention as instantly claimed.

### ***Response to Arguments***

6. Rejection made under 35 U.S.C. 112, first paragraph, is withdrawn due to Applicant amending claims 18 and 22 to remove the unsupported claim limitations.

Rejection made under 35 U.S.C. 103(a) as being as being unpatentable over Greenlee (U.S. 5,248,546) in view of Busby et al (U.S. 4,127,685) is withdrawn. Greenlee is maintained as the reference comprises at least two plasticizers including soya bean oil plasticizer. Applicant's argue the Greenlee reference states that liquid plasticizers such as epoxidized soy oil are detrimental at column 14, lines 38-43. Greenlee does not explicitly teach that epoxidized soybean oil is absent from the pvc layers, but actually teaches that it is present in the pvc layers. Although Greenlee teaches epoxidized soy oil are detrimental for that particular embodiment of the invention, Greenlee also teaches the epoxidized soy oil is present at a minimal level, which means it is still present in the pvc layer and teaches the epoxidized soybean oil is included to improve heat stability (column 5, lines 59-65 and column 14, lines 41-43).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the layered structure is preferably not objectionable for direct food contact) are not recited in the rejected claim(s). Although the claims are interpreted in light of the

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specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Although Applicant claims a packaging film, Applicant does not claim the material is in contact with food.


### **Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
L. Ferguson  
Patent Examiner  
AU 1774

  
RENA DYE  
SUPERVISORY PATENT EXAMINER  
A.U. 1774 6/8/06